

ALEX L. YIP ATTORNEY AT LAW

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27 OCT 1998

Legal Staff International Division

DEC 2 9 1998

Group 2700

141-15 HOOVER AVENUE BRIARWOOD, NEW YORK 11435

TEL: (718) 297-8182

FAX: (718) 297-5218

303 Rec'd PCT/PTO 1 ¥ AUG 1998

FAX TRANSMISSION

October 27, 1998

To:

Examiner Jennifer Bahr

**PCT Legal Examiner** 

FAX NUMBER:

(703) 308-6459

PHONE NUMBER:

(703) 305-9849

FROM:

Alex L. Yip

PAGES:

25 including the cover page

MESSAGES:

# CONFIDENTIALITY NOTICE

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DEC 2 9 1998 Group 2700

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application: Schwartz et al.

Serial No.

08/973,293

PCT No.

PCT/US97/06831

Int. Filing Date: April 23, 1997

Priority Date

April 23, 1996

For

Secure Postage Payment System and

Method

# Facsimile Cover Letter

Hon. Commissioner of Patents and Trademarks Box PCT Washington, D.C. 20231

Attention: Examiner Jennifer Bahr

PCT Legal Examiner International Division

Legal Staff

Sir:

As requested by Examiner Jennifer Bahr, applicant encloses herewith a true copy of the Renewed Submission under 37 CFR 1.42 in the above-identified patent application, which was sent to the U.S. Patent and Trademark Office by Express Mail on August 11, 1998. A copy of a return postcard acknowledging the receipt by the PCT/PTO of the Renewed Submission on August 11, 1998, and a copy of an Express mail mailing label whose number is indicated on the Renewed Submission are also enclosed.

Please note that a typographical error has been found at page 2, line 9 of the Renewed Submission. date "June 27, 1997" there should read "June 17, 1997." Respectfully submitted,

Alex L. Yip, Attorney PTO Reg. No. 34,759

(718) 297-8182

Date: October 27, 1998

Enclosures

COMMISSIONER OF PATENTS AND TRADEMARKS, BOX <u>PCT</u>

Inventor-Case No. \_\_\_\_\_AISCHWARTZ1-PCT

Stamp of the USPTO acknowledging receipt is requested

Renewed Submission Under 37 CFR 1.42 (including Exhibits 1, 2 & 3)

Serial No. <u>08/973,293</u>

PCT No. PCT/US97/06831

Express Mail mailing no. EF414180524US

10 Rec'd PCT/PTO 1 1 AUG 1998

EXPRESS MAIL

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# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application: Schwartz et al.

Serial No. : 08/973,293

PCT No. : PCT/US97/06831

Int. Filing Date : April 23, 1997

Priority Date : April 23, 1996

For : Secure Postage Payment System and

Method

# RENEWED SUBMISSION UNDER 37 CFR 1.42

# Certificate of Mailing by "Express Mail" Under 37 C.F.R. 1.10

"Express Mail" Label No. <u>EE414180524US</u>. Date of Deposit <u>Aug. 11, 1998</u> I hereby certify that this paper is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" Service under 37 C.F.R. 1.10 on the date indicated above and is addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231.

Alex L. Yip PTO Req. 34,759
Name of person mailing paper

Signature of person mailing paper

Hon. Commissioner of Patents and Trademarks
Box PCT

.. - <del>-</del>

Washington, D.C. 20231

Attention: Examiner Jennifer Bahr

PCT Legal Examiner International Division

Legal Staff

Sir:

In response to a Decision on Petition under 37 CFR 1.42 and 1.44 dated July 31, 1998 in the above-identified application (Exhibit 1), applicant hereby requests that the Decision dismissing, without prejudice, an earlier request for status under 37 CFR 1.42 be reconsidered, and that the application be granted status under 37 CFR 1.42 based on applicant's Response to Invitation to Correct Defects filed on June 17, 1997 with the U.S. Receiving Office.

In a phone conversation with Examiner Jennifer Bahr on August 10, 1998, the undersigned was confirmed

Serial No. 08/973,293

21276555

-2-

that the aforementioned Response to Invitation to Correct Defects is missing from the Patent and Trademark Office records. As suggested by Examiner Bahr, a copy of such a Response as filed is enclosed and annexed hereto as Exhibit 2, which is responsive to an Invitation to Correct Defects in the International Application (PCT/RO/106) mailed on May 27, 1997. A copy of a return postcard acknowledging the receipt by the PCT/PTO of the Response on June 27, 1997, and a copy of an Express Mail mailing label whose number is indicated on the Response are annexed hereto as Exhibit 3.

In the Response to Invitation to Correct Defects, applicant submitted (i) six sheets of corrected drawing as required, (ii) a copy of a PCT General Power of Attorney under PCT Rule 90.5 by applicant Ascom Hasler Mailing Systems, Inc., and (iii) an original PCT Power of Attorney under PCT Rule 90.4 by individual inventors for the U.S. designation, in accordance with PCT Rule 4.15. Both Powers of Attorney authorize the undersigned to represent the respective parties before all the competent International Authorities in connection with the international application.

In particular, in the PCT Power of Attorney under PCT Rule 90.4, Gaye Gardner who is the legal representative of the deceased inventor Gary Gardner signed on behalf of Gary Gardner to effect the necessary power of attorney, in accordance with 37 C.F.R. 1.42.

In view of the foregoing, applicant submitted a properly signed Response which cured the defects noted in the Invitation to Correct Defects in the International

Serial No. 08/973,293

212765558

-3-

Application. As such, it is respectfully requested that the present application be granted status under 37 CFR

Respectfully submitted,

PTO Reg. No. 34,759 (718) 297-8182

Date: August 11, 1998



UNITED STATE I DEPARTMENT OF COMMERCE
Patent and Trademark Office

United States Receiving Office
United States International Searching Authority
United States International Preliminary Examining
Authority

United States Designated Office

United States Elected Office

**Address:Commissioner of Patents and Trademarks** 

Washington, D.C. 20231

Box PCT

31 JUL 1998

Alex L. Yip Attorney at Law P.O. Box 670425 Flushing, New York 11367

In re Application of

SCHWARTZ et al.

Serial No.: 08/973,293

PCT No.: PCT/US97/06831

Int. Filing Date: 23 April 1997

Priority Date: 23 April 1996

For: SECURE POSTAGE PAYMENT SYSTEM

AND METHOD

DECISION ON

PETITION

UNDER 37 CFR 1.42

AND 1.44

This is a decision on the papers filed 01 December 1997.

# BACKGROUND

On 23 April 1997, applicant filed international application PCT/US97/06831, which claimed priority of three earlier United States provisional applications filed 23 April 1996 and a fourth United States provisional application filed on 03 May 1996. Accordingly, the twenty month period for paying the basic national fee in the United States expired at midnight on 23 December 1997. A copy of the international application was not required because the international application was filed with the United States Receiving Office.

On 27 May 1997, the United States Receiving Office mailed an Invitation to Correct Defects in the International Application (PCT/RO/106) indicating that:

1) the Request filed 23 April 1997 does not comply with the signature requirements of PCT Rules 4.15 and 90.4, because it was signed by what appears to be an agent/common representative but the international application was not accompanied by a power of attorney appointing him and

2) the drawing sheets are not numbered in consecutive Arabic numerals and do not comply with the minimum margin requirements.

A review of Patent and Trademark Office records does not indicate that applicant ever provided a properly signed Request to cure the defect noted above.

On 01 December 1997, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1), a combined declaration and power of attorney as required under 35 U.S.C. 371(c)(4) executed by inventors Robert Schwartz, George Brookner, Fetneh Eskandari, Michael Brown, David Mechler and Douglas Heroy and by Gaye Gardner as legal representative of deceased inventor Gary Gardner, and a Fiduciary's Probate Certificate signed by a clerk of the Court of Probate, District of Milford, Connecticut. noted that the Fiduciary's Probate Certificate states that it is "NOT VALID WITHOUT COURT OF PROBATE SEAL IMPRESSED." The copy recorded in the Patent and Trademark Office at Reel 9101, frame 0747 does not show evidence of the seal thereon. proof of the authority of Gaye Gardner to act as legal representative for the deceased inventor in compliance with 37 CFR 1.44 requires submission of a Fiduciary's Probate Certificate which shows that the court of probate seal was impressed thereon.

# CONCLUSION

This application cannot be granted status under 37 CFR 1.42 until applicant has submitted a properly signed Request which cures the defect noted in the 27 May 1997 Invitation to Correct Defects in the International Application (PCT/RO/106). For the above reasons, the request for status under 37 CFR 1.42 is presently <u>DISMISSED</u> without prejudice.

If reconsideration of the merits of the status under 37 CFR 1.42 is desired, applicant is required to correct the above-noted defect within a time period of ONE (1) MONTH from the mail date of this decision. THIS PERIOD FOR RESPONSE MAY BE EXTENDED UP TO A MAXIMUM OF 5 MONTHS UNDER EITHER 37 CFR 1.136(a) or (b). FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42."

It is noted that proof of the authority of the legal representative in compliance with 37 CFR 1.44 MUST be submitted before the grant of a patent.

Please direct any further correspondence with respect to this matter to the Commissioner of Patents and Trademarks, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the International Division, Legal Staff.

Richard B. Lazarus

Supervisory Legal Examiner

2127655584

PCT Legal Office

Jennifer Bahr

PCT Legal Examiner. PCT Legal Office

Telephone: (703) 305-9849 Facsimile: (703) 308-6459

P465 12

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Ascom Hasler Mailing Systems, Inc.

Appln. No.: PCT/US97/06831 : April 23, 1997 Filed

Secure Postage Payment System and Method For

### RESPONSE TO INVITATION TO CORRECT DEFECTS

# Certificate of Mailing by "Express Mail" Under 37 C.F.R. 1.10

"Express Mail" Label No. <u>EG306863912US</u>. Date of Deposit <u>June 17, 1997</u> I hereby certify that this paper is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" Service under 37 C.F.R. 1.10 on the date indicated above and is addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231.

Alex L. Yip PTO Req. 34,759 Name of person mailing paper

Signature of person madling paper

Hon. Commissioner of Patents and Trademarks

Box PCT

Washington, D.C. 20231

Attention: RO/US

Sir:

In response to the Invitation to Correct Defects in the International Application mailed May 27, 1997, enclosed are six (6) sheets of new, corrected drawing including Figs. 1, 2, 3A, 3B and 4-8 for the above-identified application. Also enclosed are a copy of General Power of Attorney by applicant, and an original Power of Attorney by applicants/inventors for the United States designation.

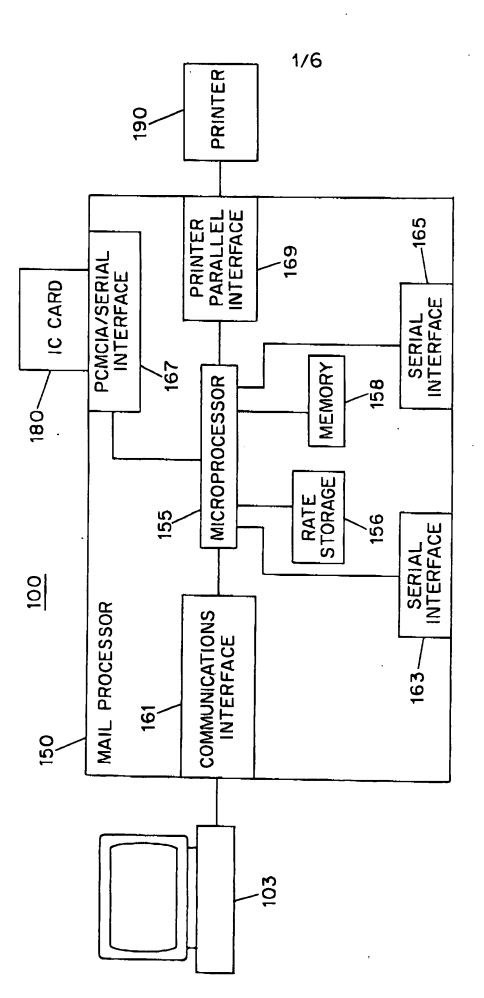
Respectfully submitted,

Alex L. Yip, Attorney PTO Req. No. 34,759

(718) 297-8182

Date: <u>June 17, 1997</u>

Enclosures



F16. 1

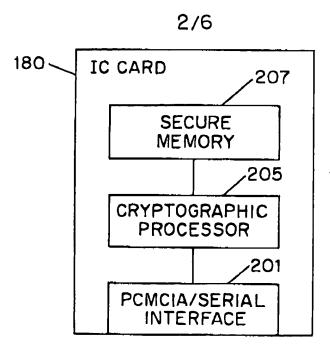


FIG. 2

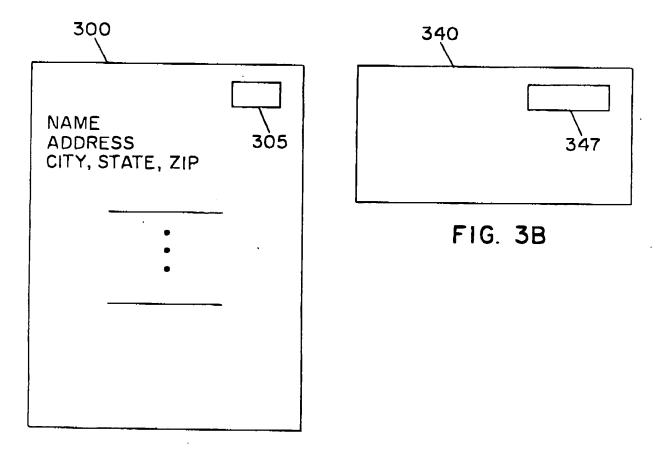


FIG. 3A



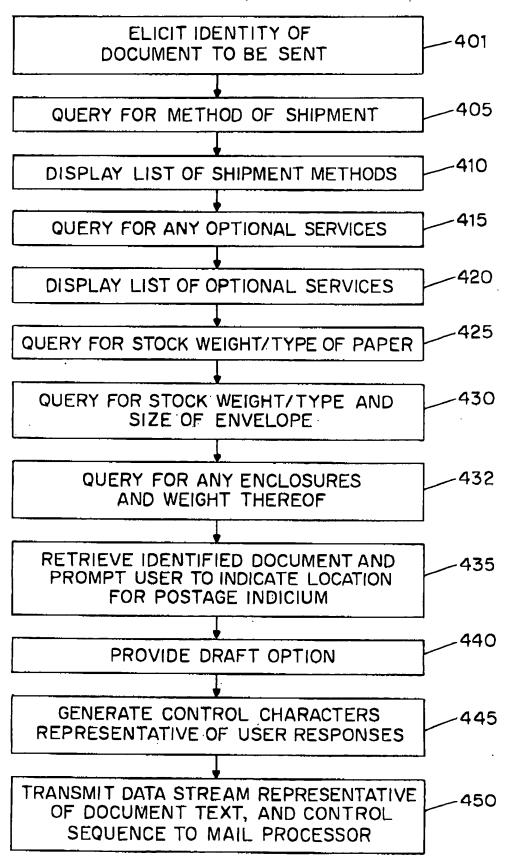


FIG. 4

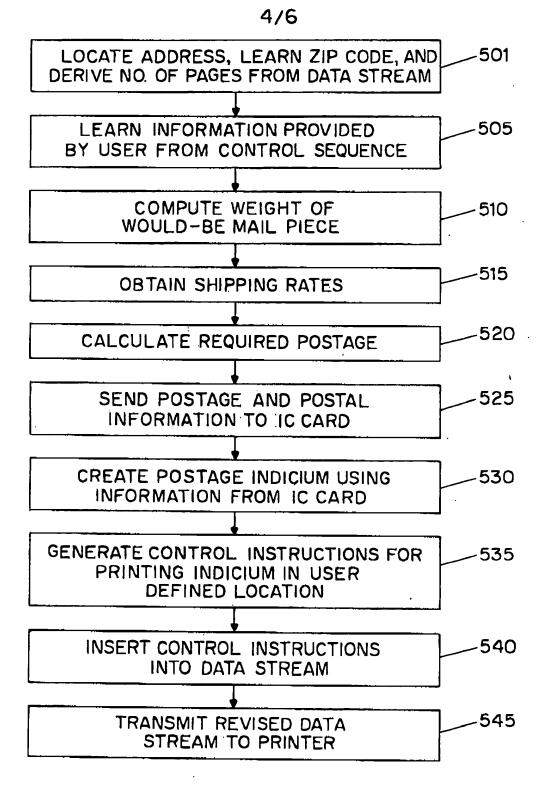


FIG. 5

5/6

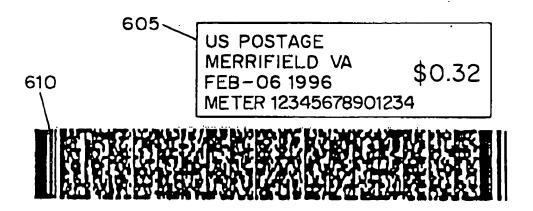


FIG. 6

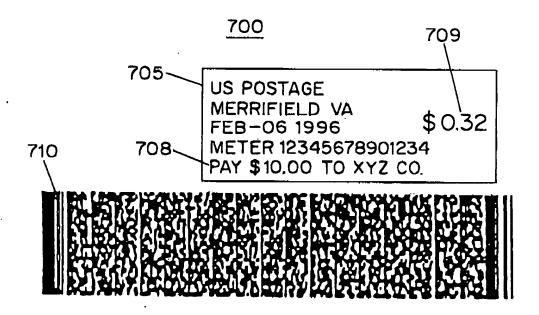


FIG. 7

6/6

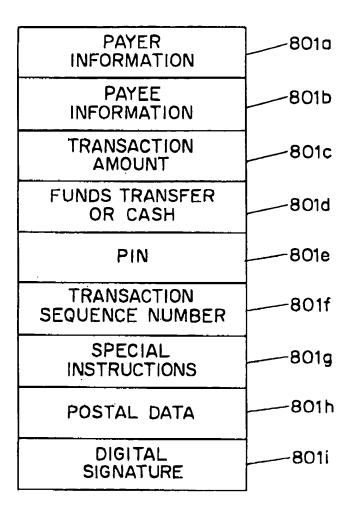


FIG. 8

# PCT GENERAL POWER OF ATTORNEY under PCT Rule 90.5

# Applicant:

Ascom Hasler Mailing Systems, Inc. of 19 Forest Parkway, P.O. Box 858, Shelton, Connecticut 60484, United States of America

hereby appoints the following person as an attorney/agent:

Yip, Alex L., Attorney at Law, of 141-15 Hoover Avenue, Briarwood, New York 11435, United States of America

to represent applicant before all the competent International Authorities in connection with any and all international applications filed by applicant with the United States Office as receiving Office and to make or receive payments on behalf of applicant.

Ascom Hasler Mailing Systems, Inc.

.e: 5/26/9/

Rv.

· VAVRA, JO

Title: SR. V. P.

SALES & MARKETT

# PCT POWER OF ATTORNEY under PCT Rule 90.4

The undersigned:

21276555

Schwartz, Robert of 191 Lindon Avenue, Branford, Connecticut 06405, United States of America; Brookner, George of 11 Surrey Drive, Norwalk, Connecticut 06851, United States of America; Eskandari, Fetneh of 166 Dove Lane, Middletown, Connecticut 96457, United States of America; Brown, Michael of 84 Field Street, Norwalk, Connecticut 06851, United States of America; Mechler, David of 34 Quaker Farms Road, Oxford, Connecticut 06478, United States of America; Gardner, Gaye, legal representative of Gardner, Gary (deceased), of 43611 Old Harbour, Bermuda Dunes, California 92201, United States of America; and Heroy, Douglas at P.O. Box 398, Meriden, New Hampshire 03770, United States of America

hereby appoint the following person as an attorney/agent:

Yip, Alex L., Attorney at Law, of 141-15 Hoover Avenue, Briarwood, New York 11435, United States of America

to represent the undersigned before all the competent International Authorities in connection with the international application identified below:

Title of the invention: Secure Postage Payment System and

Method

Attorney's/agent's file reference: AlSCHWARTZ1

International application number: PCT/US 97/06831

filed with the United States Office as receiving Office and to make or receive payments on behalf of the undersigned.

Date: 5/29/97

Robert, Schwartz

-2-

Date: 5/28/87

Date: 5/28/97

Date: 5/28/97

Gardner, Gary (deceased)

Gardner, Gaye Legal Representative of Gardner, Gary, deceased

Date: 5/22/97

COMMISSIONER OF PATENTS AND TRADEMARKS, BOX  $\underline{\hspace{0.1cm} PCT}$ 

Inventor-Case No. AISCHWARTZI-PCT

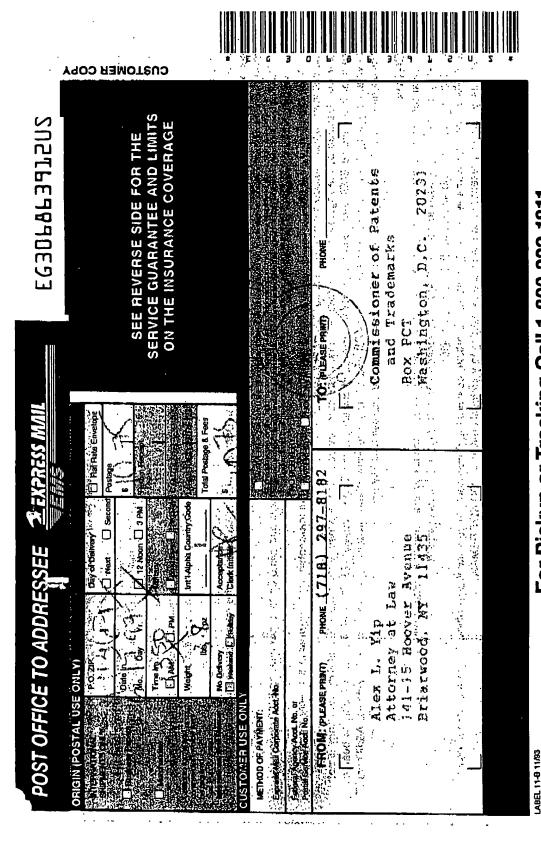
Stamp of the USPTO acknowledging receipt is requested

- 1. Response to Invitation to Correct Defects
- 2. Copy of PCT General Power of Attorney by applicant
- 3. Original Power of Attorney by applicants/inventors 2 pgs
- 4. Six (6) sheets of formal drawing

21276555

Application No. PCT/US97/06831

**89 Rec'd PCT/PTO** 17 JUN 1997



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10 Rec'd PCT/PTO 1 1 AUG 1998

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application: Schwartz et al.

Serial No. : 08/973,293

RECEIVED

PCT No. : PCT/US97/06831

Int. Filing Date: April 23, 1997 28 OCT 1998

Priority Date : April 23, 1996 Legal Staff

For : Secure Postagenigaxiiem Division and

Method

# RENEWED SUBMISSION UNDER 37 CFR 1.42

# Certificate of Mailing by "Express Mail" Under 37 C.F.R. 1.10

"Express Mail" Label No. <u>EE414180524US</u>. Date of Deposit <u>Auq. 11, 1998</u> I hereby certify that this paper is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" Service under 37 C.F.R. 1.10 on the date indicated above and is addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231.

Alex L. Yip PTO Req. 34,759
Name of person mailing paper

Signature of person mailing paper

Hon. Commissioner of Patents and Trademarks

Box PCT

Washington, D.C. 20231

Attention: Examiner Jennifer Bahr

PCT Legal Examiner International Division

Legal Staff

Sir:

In response to a Decision on Petition under 37 CFR 1.42 and 1.44 dated July 31, 1998 in the above-identified application (Exhibit 1), applicant hereby requests that the Decision dismissing, without prejudice, an earlier request for status under 37 CFR 1.42 be reconsidered, and that the application be granted status under 37 CFR 1.42 based on applicant's Response to Invitation to Correct Defects filed on June 17, 1997 with the U.S. Receiving Office.

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that the aforementioned Response to Invitation to Correct Defects is missing from the Patent and Trademark Office records. As suggested by Examiner Bahr, a copy of such a Response as filed is enclosed and annexed hereto as Exhibit 2, which is responsive to an Invitation to Correct Defects in the International Application (PCT/RO/106) mailed on May 27, 1997. A copy of a return postcard acknowledging the receipt by the PCT/PTO of the Response on June 27, 1997, and a copy of an Express Mail mailing label whose number is indicated on the Response are annexed hereto as Exhibit 3.

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In particular, in the PCT Power of Attorney under PCT Rule 90.4, Gaye Gardner who is the legal representative of the deceased inventor Gary Gardner signed on behalf of Gary Gardner to effect the necessary power of attorney, in accordance with 37 C.F.R. 1.42.

In view of the foregoing, applicant submitted a properly signed Response which cured the defects noted in the Invitation to Correct Defects in the International

Application. As such, it is respectfully requested that the present application be granted status under 37 CFR 1.42.

Respectfully submitted,

Alex L. Yip, Attorney PTO Reg. No. 34,759 (718) 297-8182

Date: <u>August 11, 1998</u>

EXHIBIT 1



UNITED STATES DEPARTMENT OF COMMERCE Patent and Trademark Office

Washington, D.C. 20231

**United States Receiving Office United States International Searching Authority** United States International Preliminary Examining Authority

**United States Designated Office** 

United States Elected Office

**Address:Commissioner of Patents and Trademarks Box PCT** 

**31** JUI 1998

Alex L. Yip Attorney at Law P.O. Box 670425 Flushing, New York 11367

In re Application of

SCHWARTZ et al.

Serial No.: 08/973,293

Int. Filing Date: 23 April 1997

Priority Date: 23 April 1996

For: SECURE POSTAGE PAYMENT SYSTEM

AND METHOD

DECISION ON

PETITION

UNDER 37 CFR 1.42

AND 1.44

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PCT No.: PCT/US97/06831

. **973,293** Serial No. 08/<del>162,093</del>

-2-

2) the drawing sheets are not numbered in consecutive Arabic numerals and do not comply with the minimum margin requirements.

A review of Patent and Trademark Office records does not indicate that applicant ever provided a properly signed Request to cure the defect noted above.

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# CONCLUSION

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If reconsideration of the merits of the status under 37 CFR 1.42 is desired, applicant is required to correct the above-noted defect within a time period of ONE (1) MONTH from the mail date of this decision. THIS PERIOD FOR RESPONSE MAY BE EXTENDED UP TO A MAXIMUM OF 5 MONTHS UNDER EITHER 37 CFR 1.136(a) or (b). FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42."

It is noted that proof of the authority of the legal representative in compliance with 37 CFR 1.44 MUST be submitted before the grant of a patent.

Please direct any further correspondence with respect to this matter to the Commissioner of Patents and Trademarks, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the International Division, Legal Staff.

Richard B. Lazarus

Supervisory Legal Examiner

PCT Legal Office

Jennifer Bahr

PCT Legal Examiner

PCT Legal Office

Telephone: (703) 305-9849 Facsimile: (703) 308-6459

TXHIBIT 2

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Ascom Hasler Mailing Systems, Inc.

Appln. No.: PCT/US97/06831 Filed : April 23, 1997

For : Secure Postage Payment System and Method

# RESPONSE TO INVITATION TO CORRECT DEFECTS

# Certificate of Mailing by "Express Mail" Under 37 C.F.R. 1.10

"Express Mail" Label No. <u>EG306863912US</u>. Date of Deposit <u>June 17, 1997</u> I hereby certify that this paper is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" Service under 37 C.F.R. 1.10 on the date indicated above and is addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231.

Alex L. Yip PTO Req. 34,759 Name of person mailing paper

Signature of person mailing paper

Hon. Commissioner of Patents and Trademarks

Box PCT

Washington, D.C. 20231

Attention: RO/US

Sir:

In response to the Invitation to Correct Defects in the International Application mailed May 27, 1997, enclosed are six (6) sheets of new, corrected drawing including Figs. 1, 2, 3A, 3B and 4-8 for the above-identified application. Also enclosed are a copy of General Power of Attorney by applicant, and an original Power of Attorney by applicants/inventors for the United States designation.

Respectfully submitted,

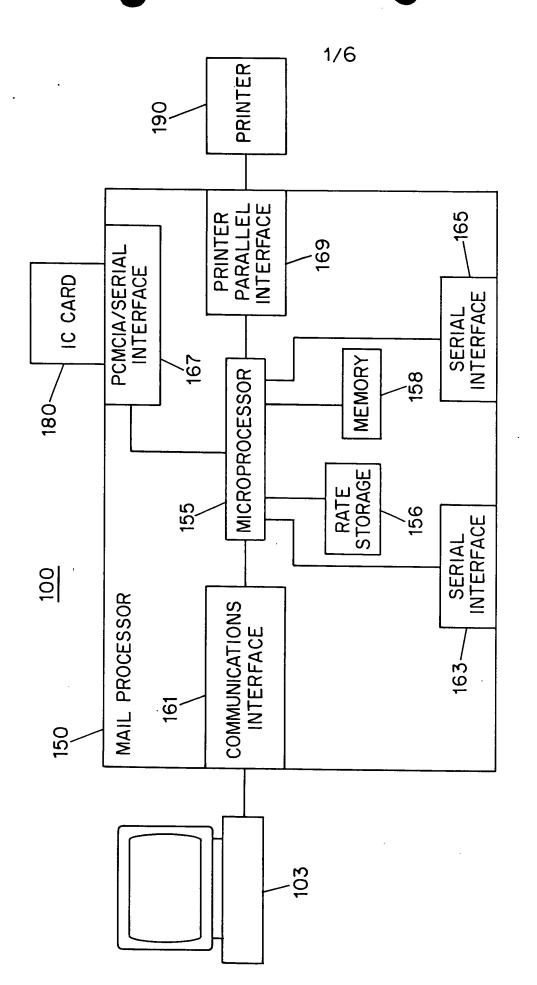
Alex L. Yip, Attorney

PTO Reg. No. 34,759

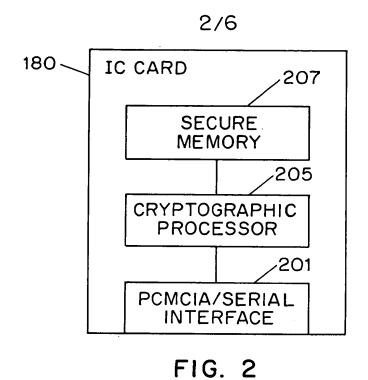
(718) 297-8182

Date: June 17, 1997

Enclosures



F16.1



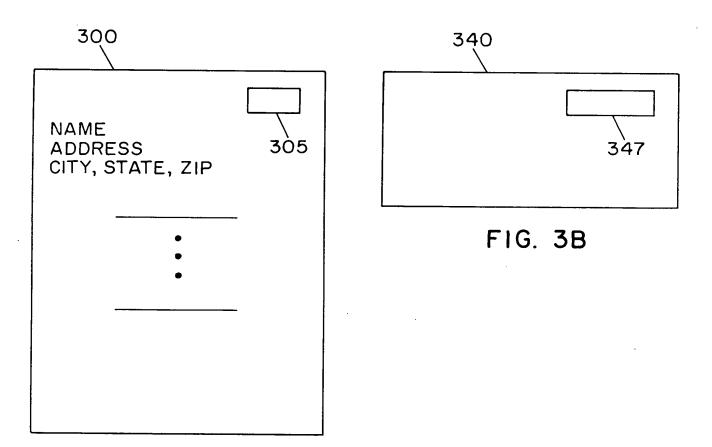


FIG. 3A

3/6

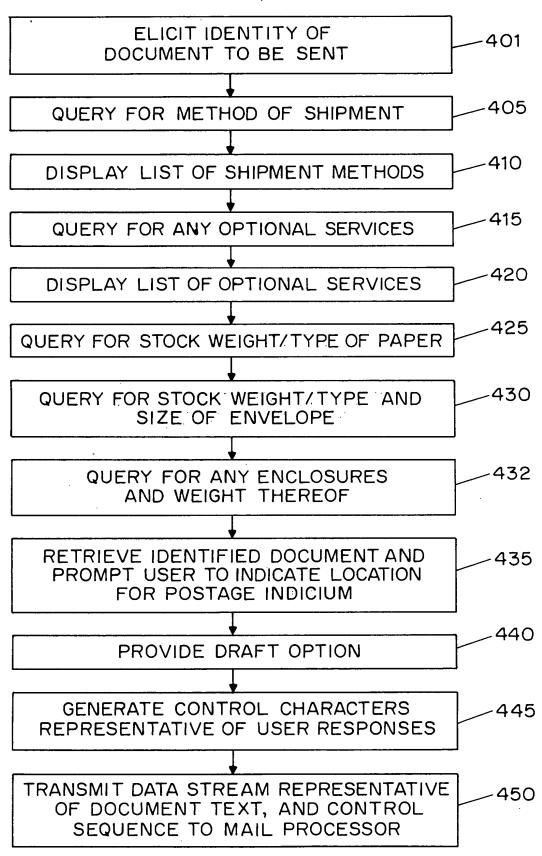


FIG. 4

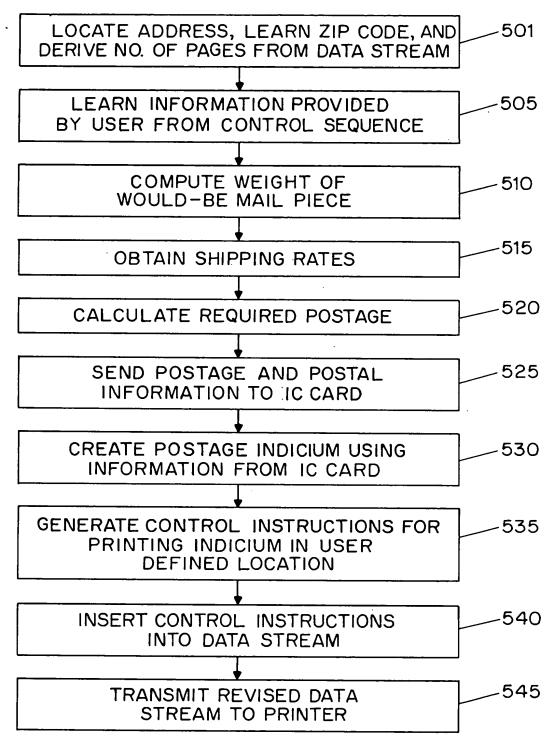


FIG. 5

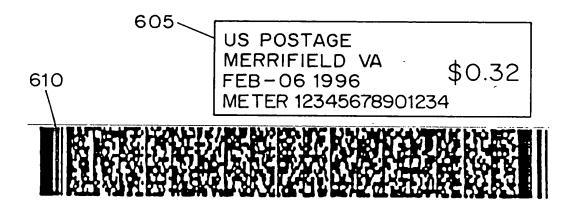


FIG. 6

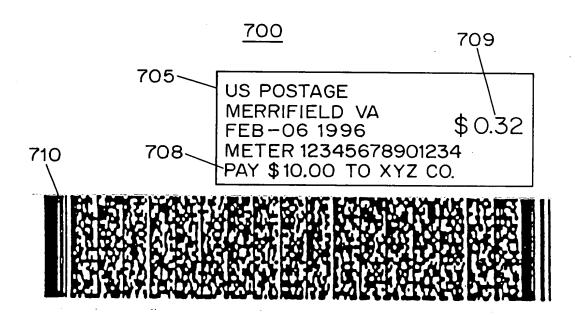


FIG. 7

8010
801b
801c
801d
801e
801f
801g
801h
801i

FIG. 8

# PCT GENERAL POWER OF ATTORNEY under PCT Rule 90.5

# Applicant:

Ascom Hasler Mailing Systems, Inc. of 19 Forest Parkway, P.O. Box 858, Shelton, Connecticut 60484, United States of America

hereby appoints the following person as an attorney/agent:

Yip, Alex L., Attorney at Law, of 141-15 Hoover Avenue, Briarwood, New York 11435, United States of America

to represent applicant before all the competent International Authorities in connection with any and all international applications filed by applicant with the United States Office as receiving Office and to make or receive payments on behalf of applicant.

Ascom Hasler Mailing Systems, Inc.

# PCT POWER OF ATTORNEY under PCT Rule 90.4

The undersigned:

Schwartz, Robert of 191 Lindon Avenue, Branford, Connecticut 06405, United States of America; Brookner, George of 11 Surrey Drive, Norwalk, Connecticut 06851, United States of America; Eskandari, Fetneh of 166 Dove Lane, Middletown, Connecticut 96457, United States of America; Brown, Michael of 84 Field Street, Norwalk, Connecticut 06851, United States of America; Mechler, David of 34 Quaker Farms Road, Oxford, Connecticut 06478, United States of America; Gardner, Gaye, legal representative of Gardner, Gary (deceased), of 43611 Old Harbour, Bermuda Dunes, California 92201, United States of America; and Heroy, Douglas at P.O. Box 398, Meriden, New Hampshire 03770, United States of America

hereby appoint the following person as an attorney/agent:

Yip, Alex L., Attorney at Law, of 141-15 Hoover Avenue, Briarwood, New York 11435, United States of America

to represent the undersigned before all the competent International Authorities in connection with the international application identified below:

Title of the invention: Secure Postage Payment System and

Method

Attorney's/agent's file reference: A1SCHWARTZ1

International application number: PCT/US 97/06831

filed with the United States Office as receiving Office and to make or receive payments on behalf of the undersigned.

Date: 5/29/97

Robert, Schwartz

Date: 5/28/87	Brookner, George
Date: 5/28/97	Folks Elastra Eskandari, Fetneh
Date: 5/28/97	Brown, Michael
Date: 1/1/94	Mechler, David
	Gardner, Gary (deceased)
Date: <u>6-9-97</u>	By: Aug Audust Gardner, Gaye Legal Representative of Gardner, Gary, deceased
Date: 5/22/97	Douglas Heroy Douglas

EXHIBIT3

# COMMISSIONER OF PATENTS AND TRADEMARKS, BOX PCT

Inventor-Case No. <u>A1SCHWARTZ1-PCT</u>

# Stamp of the USPTO acknowledging receipt is requested

- 1. Response to Invitation to Correct Defects
- 2. Copy of PCT General Power of Attorney by applicant
- 3. Original Power of Attorney by applicants/inventors 2 pgs
- 4. Six (6) sheets of formal drawing

Application No. PCT/US97/06831

**80 Rec'd PCT/PTO**17 JUN 1997

